



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,696	07/25/2001	Philip Staehelin	38729-170990	3956

26694 7590 11/05/2004

VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,696	STAEHELIN, PHILIP	
	Examiner	Art Unit	
	Salad E Abdullahi	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/11/2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/25/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-36 are pending. The rejections cited stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 recites the limitation " the display device " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard U.S. Patent No. 6,182,050[hereinafter Ballard].

As per claim 1, Ballard discloses a method for obtaining and presenting data to a user, comprising:

Art Unit: 2157

receiving data at a user device, the data being received via a downloading process that is adjusted to reflect on-line activity at the first device (see col. 3, lines 21-35 and col. 7, lines 21-25);

storing the data at the first device (see col. 3, lines 24-29); and

presenting the stored data to the user regardless of network connectivity of the user device (i.e., presenting data whether end user is on-line or off-line) (see col. 3, lines 21-25 and col. 13, lines 4-25).

As per claim 2, Ballard discloses the method according to claim 1, further comprising: determining when specific sets of data are presented to the user(see col. 7, lines 36-49); and

requesting new data to replace the presented data (see col. 7, lines 36-49).

As per claim 3, Ballard discloses the method according to claim 2, wherein the specific sets of data are advertisements (see col. 7, lines 36-49).

As per claim 4, Ballard discloses the method according to claim 1, wherein the user device initiates the downloading process (see col. 13-15).

As per claim 5, Ballard discloses a method for obtaining and presenting data to a user, comprising:

Art Unit: 2157

determining when data is to be downloaded to a first device (see col. 4, lines 10-13 and col. 7, lines 36-49);

detecting when the first device is online (see col. 10, 13-14);

when data is to be downloaded and when the first device is on-line, initiating a download of data at the first device, the data being downloaded based on on-line activity of the first device (see col. 10, lines 1-26); and

presenting the data to the user via the first device, regardless of network connectivity of the first device (i.e., whether end user is on-line or off-line) (see col. 10, lines 1-26).

As per claim 6, Ballard discloses the method according to claim 5, further comprising storing the downloaded data at the first device (see col. 10, lines 5-7).

As per claim 7, Ballard discloses the method according to claim 5, further comprising: providing user profile information from the first device to a second device (see col. 3, lines 8-20); and

receiving data from the second device, the data being selected based on the user profile information (see col. 3, lines 11-14).

As per claim 8, Ballard discloses the method according to claim 5, wherein the first device is a personal computer (see fig. 1, element 14).

As per claim 9, Ballard discloses the method according to claim 8, further comprising

Art Unit: 2157

storing the downloaded data on a storage device of the display device (see col. 10, lines 5-7).

As per claim 10, Ballard discloses the method according to claim 7, wherein the initiating step comprises:

sending a log-in request from the first device to a second device every time the first device goes on-line (see col. 3, lines 14-15).

As per claim 11, Ballard discloses the method according to claim 10, wherein the log-in request includes a user ID (code identifying end user) (see col. 9, lines 49-67).

As per claim 12, Ballard discloses the method according to claim 7, further comprising sending a content information request to the second device (i.e., advertisement information) (see col. 4, lines 23-20).

As per claim 13, Ballard discloses the method according to claim 7, wherein the second device is a server (see fig. 1, element 12).

As per claim 14, Ballard discloses the method according to claim 5, further comprising setting a flag (i.e., code) associated with the data that is presented to the user (see col. 10, lines 27-33).

Art Unit: 2157

As per claim 15, Ballard discloses the method according to claim 14, wherein the determining step comprises:

checking the flag for the data (see col. 12, lines 41-65); and

requesting new data for each data with its flag set (see col. 12, lines 41-65).

16. The method according to claim 15, wherein the new data replaces the data with its flag set (see col. 12, lines 41-65).

AS per claim 17, Ballard discloses the method according to claim 5, wherein the data includes advertisements (see col. 10, lines 1-26).

As per claim 18, Ballard discloses the method according to claim 17, wherein the advertisements are presented to the user as at least one of a screensaver, wallpaper, a start-up screen, and a shut-down screen (see col. 13, lines 8-17).

As per claim 19, Ballard discloses the method according to claim 5, wherein the presenting step comprises selecting specific ones of the data to present to the user; and tracking the specific ones of the data presented to the user (see col. 7, lines 50-55).

As per claim 20, Ballard discloses the method according to claim 19, wherein the selecting step comprises:

Art Unit: 2157

selecting data that has not previously been presented to the user (see col. 12, lines 41-65); and

if no data remains that has not previously been presented to the user, re-presenting data to the user (see col. 12, lines 41-65).

As per claim 21, Ballard discloses the method of providing data to a user device, comprising:

receiving a request initiated by a user device, the request including a user ID (see col. 9, lines 49-67);

associating the user ID with a user profile (i.e., demographic information) (see col. 7, lines 3-10);

determining, based on the user profile, select data to be provided to the user device (see col. 4, lines 10-13 and col. 7, lines 36-49); and

downloading the select data to the user device based on on-line activity of the user device (see col. 10, lines 1-26).

As per claim 22, Ballard discloses the method according to claim 21, further comprising receiving the data from a third party (i.e., advertisers), the data to be provided to users based on a target audience, the third party having no knowledge of the user profiles (see col. 8, lines 44-62)..

As per claim 23, Ballard discloses the method according to claim 21, further comprising

Art Unit: 2157

receiving a user profile from the user device when the user device **initially logs-in** (see col. 7, lines 3-130).

As per claim 24, Ballard discloses the method according to claim 21, wherein the user profile includes at least one of a name, address, hobbies, education level, salary or other characteristics of a user (see col. 7, lines 3-10).

As per claim 25, Ballard discloses the method according to claim 21, wherein the data includes advertisements (see col. 10, lines 1-26).

As per claim 26, Ballard discloses the method according to claim 25, wherein the user profile indicates a type of advertisement the user wishes to receive or has been selected, based on his profile, to receive (see col. 7, lines 14-31).

As per claim 27, Ballard discloses the method according to claim 21, wherein the request includes a content information request.

28. The method according to claim 27, further comprising, in response to the content information request, providing a content response including an address (i.e., hyper-lined address) where the data to be downloaded is located, to the user device (see col. 13, lines 20-25).

Art Unit: 2157

As per claim 29, Ballard discloses the method according to claim 28, wherein the address is an URL address (the hyper-linked address inherently includes URL address) (see col. 13, lines 20-25).

As per claim 30, Ballard discloses a computer system for providing targeted information to users, comprising:

a server device(see fig. 3, element server 52) including:

means for receiving a plurality of information messages, the information messages being associated with at least one of a plurality of target audiences (participating consumers) (see col. 8, lines 44-52 and col. 9, lines 29-48);

a profile manager (60) for managing user profiles (58), the user profiles including information to associate users with the target audiences (see col. 6, lines 40-63);

a content supplier (advertiser) providing a format of the information message for the user (see col. 8, lines 53-56);

an upload component (ASP 52) storing the plurality of information messages (see col. 6, lines 25-29);

a server component receiving requests for information messages, the requests including data to associate the request with a user profile, and sending information messages in response to the requests, the information messages that are sent being determined by comparing the target audience for the information message and the user profile (see col. 6, lines 40-63).

Art Unit: 2157

As per claim 31, Ballard discloses the system according to claim 30, wherein some of the plurality of information messages is provided to a plurality of users (see col. 6, lines 40-63).

As per claim 32, Ballard discloses the system according to claim 30, further comprising a means for charging based upon the number of users a message is provided to 9see col. 10, lines 63-67).

As per claim 33, Ballard discloses the system according to claim 30, further comprising a client (end user computer 14) including:

means for obtaining profile information from a user (see col. 7, lines 50-65);

means for determining that new information messages are needed(see col. 7, lines 50-65);;

means for initiating communication with the server to retrieve the new information messages (see col. 7, lines 50-65);and

means for tracking the presentation of information (see col. 7, lines 50-65);

As per claim 34, Ballard discloses the system according to claim 33, wherein the server device further comprises means for generating a unique user ID for the client devices (see col. 9, lines 55-58).

As per claim 35, Ballard discloses the system according to claim 30, wherein a number

Art Unit: 2157

of users are grouped together in a user profile.

As per claim 36, Ballard discloses a computer useable information storage medium storing computer readable program code means for causing a computer to perform the steps of:

determining when data is to be downloaded to a first device (see col. 4, lines 10-13 and col. 7, lines 36-49);

detecting when the first device is online (see col. 4, lines 10-13);

when data is to be downloaded and when the first device is on-line, initiating a download of data at the first device, the data being downloaded to the first device based on on-line activity of the first device (see col. 10, lines 1-26);and

presenting the data to the user via the first device, regardless of network connectivity of the user device (i.e., whether end user is on-line or off-line) (see col. 10, lines 1-26).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can

Art Unit: 2157

be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:


Box AF

Commissioner of Patents and

Trademarks

Washington, DC 20231

or faxed to: (703) (872-9306).


Abdullahi Salad
Examiner AU2157
10/18/2004